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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC POLESUK

Appeal 2009-015298
Application 10/072,528
Technology Center 3700

Before RICHARD E. SCHAFER, ROMULO H. DELMENDO, and
RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 by the Patent Applicant from the Patent Examiner's rejections of claims 9 and 10 as obvious. The Board's jurisdiction for this appeal is under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

The claimed invention relates to a method of dispensing hair foil. According to the patent application, hair foil

. . . is widely used in the Professional Beauty Industry on both woman [sic] and men of all ages during the application of hair color. The foil itself is used to isolate specific strands of hair so that a specific shade of hair color can be applied to those strands without affecting the other strands nearby. This approach allows a particular effect or "look" to be created in a client's hair.

(Spec.¹, p. 1, ll. 16-20).

Claims 9 and 10 are pending and stand rejected by the Patent Examiner as follows: claims 9 and 10 under 35 U.S.C. § 103(a) as obvious in view of Conway² (Ans. 3); and claims 9 and 10 under 35 U.S.C. § 103(a) as obvious in view of Leto³ (*id.* at 3-4). Appellant challenged the Examiner's determination and provided evidence of commercial success of the claimed method.

Claim 9 is representative and reads as follows:

9. A method of putting hair foil in a person's hair consisting of: removing a first sheet of hair foil from a pop-up dispenser; said first sheet of hair foil ranging in width from about 3.5 to 6 inches;

¹ "Spec." refers to the written description of Application No. 10/072,528, the subject of this Appeal.

² U.S. Patent No. 2,087,181 issued July 13, 1937.

³ U.S. Patent No. 4,185,753 issued Jan. 29, 1980.

said sheet of hair foil having a lead portion and a trailing portion;
said lead portion of said sheet of hair foil extending through a dispensing orifice to an elevation above that of said dispensing unit;
said trailing portion of said first hair foil sheet overlapping with a lead portion of a next hair foil sheet to be dispensed;
pulling said next hair foil sheet through said orifice of said dispenser by withdrawing said first sheet of hair foil;
said next hair foil sheet ranging in width from about 3.5 to 6 inches; and applying said first hair foil sheet to a person's hair.

CLAIM INTERPRETATION

Legal Principles

[I]n patent lexicography . . . [it] is equally well understood . . . that “consisting of” is closed-ended and conveys limitation and exclusion. *See Norian Corp. v. Stryker Corp.*, 363 F.3d 1321 (Fed. Cir. 2004) (““consisting of” is a term of patent convention meaning that the claimed invention contains only what is expressly set forth in the claim . . . [however] it does not limit aspects unrelated to the invention”); *In re Gray*, 19 C.C.P.A. 745, 53 F.2d 520 (CCPA 1931) (the use of the claim term “consists” is limited to the claim's enumerated alloy metals without other elements, unlike the term “comprising” which permits the inclusion of other metals than those claimed”).

CIAS, Inc. v. Alliance Gaming Corp., 504 F.3d 1356, 1361 (Fed. Cir. 2007).

Discussion

Claim 1 is directed to a method “of putting hair foil in a person's hair consisting of”:

- “removing a first sheet of hair foil from a pop-up dispenser,”

- “pulling said next hair foil sheet through said orifice of said dispenser,”
- “withdrawing said first sheet of hair foil,” and
- “applying said first hair foil sheet to a person’s hair.”

The term “consisting of” is “closed-end” and limits the claim to the recited steps. *CIAS, Inc.*, 504 F.3d at 1361.

Claim 1 contains a “pop-up dispenser” from which sheets of hair foil are removed. The only structure of the pop-up dispenser explicitly recited in the claim is that it has “a dispensing orifice to an elevation above that of said dispensing unit.” Because the claim does not recite the structure of the pop-up dispenser that would enable it to perform its hair foil dispensing function (“removing” and “pulling said next hair foil sheet” from the dispenser), the claim would reasonably be understood by the skilled worker to be open to additional structures which would enable this function. That is, the “consisting of” language in claim 1 does not exclude the pop-up dispenser from having additional structural elements not recited in the claim.

OBVIOUSNESS REJECTIONS

Legal Principles

The Examiner bears the burden of establishing a prima facie case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010). Once prima facie obviousness is established, Appellant has the burden of providing arguments and evidence to rebut it. *Oetiker*, 977 F.2d at 1445.

“[I]t is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456 (CCPA 1955).

Conway rejection

The Examiner found that Conway described the claimed method steps of putting hair foil in a person's hair by removing the foil from a dispensing container (Ans. 3). The Examiner found that the only difference between Conway's method and the claimed method was that Conway did not describe the foil sheets as "ranging in width from about 3.5 to 6 inches" as recited in the claim (*id.*). However, the Examiner determined that the claimed width would have been obvious to the ordinary skilled worker "since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233." (*Id.*)

Appellant did not dispute the Examiner's conclusion that the claimed foil sheet size would have been obvious to the skilled worker in the art. Rather, Appellant stated that "Conway requires a spring to bear against a package of sheets. . . . The clamps of Conway attached to a roller which is in contact with such solutions, are subject to wear and corrosion after repeated use." (Br. 8.) Appellant contends that these elements are excluded from the claim by the claim language "consisting of." (*Id.* at 11.)

Claim 9 would be reasonably interpreted by one of ordinary skill in the art to permit the claimed pop-up dispenser to contain structures in addition to those recited in the claim ("Claim Interpretation," *supra.*). We reached this conclusion because the claim did not recite the structures which enabled the dispenser to dispense hair foil. Thus, unrecited structure is responsible for enabling the pop-up dispenser to dispense foil and the claim would be reasonably understood to be open to such structure. The "consisting of" language limits the steps of the claimed method, but not the

structure of the pop-up dispenser. Consequently, the claim does not exclude the springs said by Appellant to be present in Conway's hair foil dispenser.

In sum, we conclude that the Examiner had adequate evidence to establish prima facie obviousness of the claimed subject matter. *Oetiker*, 977 F.2d at 1445; *Frye*, 94 USPQ2d at 1075.

Leto rejection

The Examiner found that Leto described the same method steps as claimed, but did not described foil sheets as "ranging in width from about 3.5 to 6 inches" as recited in the claim (Ans. 4). However, the Examiner made the determination that it would have been obvious to the skilled worker to have discovered the optimal working ranges for the foil sheet dimensions (*id.*).

Appellant contends:

- "Leto relates to end wraps. . . . The hair foil of the claims is 3.5 to 6" in width and when dispensed is approximately 11" long. This is significantly longer than an end wrap paper, having an average size of 3-4" in width and 3-4" long" (Br. 10);

- "the foil of the present application is significantly heavier than the paper described in Leto" (*id.*); and

- "it is realistic to place a small light weight box of end wraps on your arm utilizing the device taught by Leto. It would not be feasible for one skilled in the art of hair coloring to wear such a heavy box of foil on their wrists/arms while performing a hair color service" because it weighs more than the lightweight box of end wraps described in Leto (*id.* at 10-11).

Hair Foil Width and Length

The claim requires that the hair foil range “in width from about 3.5 to 6 inches.” Appellant contends that Leto’s end wraps have a smaller width.

This argument is not persuasive because Leto did not limit its disclosure to end wraps. Leto stated that the “present invention . . . provides a dispenser for flexible sheet matter, *particularly* end wraps” (Leto, col. 2, ll. 57-59; emphasis added). Thus, while end wraps may have been preferred, Leto’s disclosure is not limited to them.

As for Appellant’s contention that Leto’s wrap is 11 inches, the claim is not limited to a particular length foil, and as mentioned, Leto’s disclosure is not restricted to end wraps (*id.*).

Foil and Dispenser Weight

Leto described “a device for dispensing a plurality of flexible sheets adapted to be worn on the human arm” (Leto, col. 3, ll. 17-19). Leto described the device as useful in cosmetology (*id.* at col. 1, ll. 5-7). Appellant contends that the claimed dispenser of hair foil is heavier than the end wrap dispenser described in Leto and that it would not be “feasible” to wear a “heavy box of foil” on the arm as taught by Leto (Br. 10-11).

This argument is not persuasive. Appellant did not provide adequate evidence that hair foil would be heavier than the flexible sheets disclosed in Leto. Arguments of counsel cannot take the place of evidence lacking in the record. *Estee Lauder, Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997).

Moreover, the claims are not limited to a particular weight of foil, dispenser size, or number of foil sheets within the dispenser. In view of

Leto's teaching of the advantages of an arm-worn dispenser, persons of ordinary skill in the art would have known to adjust the sheet number and dispenser weight so it could be worn on the arm as taught by Leto. As concluded by the Examiner, it is "not inventive to discover the optimum or workable ranges by routine experimentation." *Aller*, 220 F.2d at 456.

Commercial Success

Issue

The Examiner provided sufficient evidence to establish prima facie obviousness of the claimed subject matter, shifting the burden to Appellant to rebut the Examiner's determination. It is well established that prima facie obviousness can be rebutted by evidence of secondary considerations. Appellant provided a declaration by Eric Polesuk, President and CEO of Product Club Corp, and the inventor of the patent application involved in this appeal (Polesuk Declaration 1, dated May 30, 2006). Mr. Polesuk stated in his written declaration that the claimed method "creates a convenient and time saving way of dispensing hair foil which has led to Product Club's success." (*Id.* at ¶ 7.) Mr. Polesuk stated that the market share and profitability of Product Club's pop-up foil dispenser "must be directly linked to the method in which the pop-up foil is being dispensed and placed in the hair." (*Id.* at ¶ 9.)

The issue is whether Appellant provided adequate evidence of commercial success to establish non-obviousness of the claimed method.

Legal Principles

“Ordinarily, [a] nexus may be inferred when ‘the patentee shows both that there is commercial success, and that the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent.’” *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1324 (citing *Demaco Corp. v. F, Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988)).

“Denso argues that this [sales] evidence is insufficient because Tec Air failed to provide market share data. Although sales figures coupled with market data provide stronger evidence of commercial success, sales figures alone are also evidence of commercial success.” *Tec Air, Inc. v. Denso Mfg. Mich., Inc.*, 192 F.3d 1353, 1361 (Fed. Cir. 1999).

In the present case, Huang has simply not provided sufficient information upon which the PTO could determine whether the grips were commercially successful. Although Huang’s affidavit certainly indicates that many units have been sold, it provides no indication of whether this represents a substantial quantity in this market. This court has noted in the past that evidence related solely to the number of units sold provides a very weak showing of commercial success, if any. *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996).

The ultimate determination of whether an invention is obvious is a legal question based on the totality of the evidence. *Richardson-Vicks, Inc. v. The Upjohn Co.*, 122 F.3d 1476, 1483 (Fed. Cir. 1997).

Discussion

Mr. Polesuk described the differences between the claimed pop-up dispenser method and roll pre-cut hair foil (Polesuk Decl. ¶¶ 2, 4, & 6):

2. Product Club began selling the pop-up foil described in the above patent application in the fourth quarter of 2001. Prior to this time, Product Club had been selling roll foil and pre-cut foil to the Beauty Industry. Roll foil is defined as foil that is on a roll that can be cut when needed and used for hair coloring applications. Pre-cut foil is defined as foil that is stacked, one sheet on top of another, much like a deck of playing cards, which can then be used for haircoloring applications.

4. The claims of the present invention . . . relate to the pop-up foil . . . By withdrawing the first sheet of hair foil, the next hair foil sheet is pulled through the, orifice of the dispenser, and is awaiting further use.

6. With the pre-cut foil, the first sheet, and each subsequent sheet of foil, must be separated from the stack of foil before being applied to a person's hair. Therefore, the second sheet, and each subsequent sheet, is not ready for use. This process requires multiple steps that are not required with the pop-up foil method.

Mr. Polesuk further stated in his declaration:

8. From 2001 until today, the market share for Product Club's pop-up foil has gone from 0% in 2001 to almost 60% in 2005 of the foil being sold by Product Club to the Beauty Industry. Product Club's pop-up foil sales have almost tripled in size since 2002. The other foil products such as roll foil and pre-cut foil have not grown to the same extent.

We agree with the Examiner that the information disclosed by Mr. Polesuk is not sufficient to establish non-obviousness.

Commercial success can be shown by evidence of market share. *Cf. Tec Air, Inc.*, 192 F.3d at 1361; *Huang*, 100 F.3d at 140. The “market” refers to the sphere of commercial activity in which a product is sold. The relevant market therefore constitutes the suppliers and buyers of a given product. In this case, Mr. Polesuk did not describe what share of the market

had been garnered by Product Club's commercial product, but only reported the sales percentage for its own company and not for other suppliers of hair foil (Polesuk Decl. ¶ 8). Consequently, Appellant did not provide sufficient evidence of commercial success in the marketplace for hair foils.

As for the growth in pop-up foil dispenser sales for its own company, Appellant did not establish that its stated success was based on the merits of its own invention, rather than that of the prior art. For example, Appellant admits in its patent application that pop-up dispensers were known and available in the prior art (Spec., p. 5, ll. 9-14, 19-20, & 29-30). "[T]he asserted commercial success of the product must be due to the merits of the claimed invention beyond what was readily available in the prior art." *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997).

Furthermore, Mr. Polesuk testified in his declaration that sales of pop-up foil tripled in size from 2005 and outperformed other products (Polesuk Decl. § 8). However, Mr. Polesuk did not present sales data for the other products, nor did he identify what those products were, nor did he show that the features of the claimed invention were responsible for the sales, rather than advertising or other unrelated factors. Consequently, for these reasons as well, the data is unavailing.

SUMMARY

Based on the totality of the evidence before us, we conclude that claims 9 & 10 are obvious in view of the Conway and Leto patents.

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Application 10/072,528

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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